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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,537	07/20/2001	James M. Mathewson II	RSW920010103US1	1973

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EXAMINER

CHEA, PHILIP J

ART UNIT PAPER NUMBER

2153

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,537

Applicant(s)

MATHEWSON ET AL.

Examiner

Philip J. Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 9-12, 14-20, 22-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9-12, 14-20, 22-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Office Action is in response to a Request for Continued Examination filed July 13, 2006.

Claims 1-5,7,9-12,14-20,22-24 and 26 are currently pending. Any rejection not set forth below has been overcome by the current Amendment.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5,7,9-12,14-20,22-23, rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1,5,7,18,20,22,24 contain the limitation of forcing a recipient to respond. It is unclear how the limitation will be enabled for the reason that a recipient may be away from their desk or the computer may not be turned on in order for the recipient to respond. A person skilled in the art would not be able to enable the invention for at least those reasons.

Any claim not mentioned specifically has been rejected by virtue of being dependent upon a rejected claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-5,7,9-12,14-20,22-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 5,325,310), herein referred to as Johnson, and further in view of Boulton et al. (US 5,537,618), herein referred to as Boulton.

As per claims 1,18,22, Johnson discloses marking a message, by a creator thereof (see column 5, lines 1-13);

sending the marked message from a computing device of the creator to a computing device of a recipient for whom the message was created such that after the marked message is received at the computing device of the recipient, the recipient will be forced to respond thereto (see column 6, lines 42-48); and

automatically receiving a reply from the recipient, sent from the computing device of the recipient to the computing device of the creator following the recipient's response thereto (see column 6, lines 42-48).

Although the system disclosed by Johnson shows substantial features of the claimed invention (discussed above), it fails to disclose marking the message as time-sensitive, automatically rendering the message to the recipient, forcing the recipient to respond within a time period of the time-sensitivity, and receiving a response from the recipient within the time period of the time-sensitivity.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Johnson, as evidenced by Boulton.

In an analogous art, Boulton discloses a system to improve feedback from user by customizing the feedback message options (see Abstract), wherein a message marked as time-sensitive and automatically rendered to a recipient (see column 17, lines 46-50 and 57-61). Since Boulton shows that the message can be automatically rendered during an urgent time period (see paragraph [0062]), it would be obvious to combine the teaching of Johnson of forcing the recipient to respond once that message is automatically rendered, and receive a response from the recipient as taught above by Johnson.

Given the teaching of Boulton, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Johnson by employing a timely and automatic

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email rendering to a recipient, such as disclosed by Boulton, in order to ensure that a recipient views a message and provides feedback for an urgent project.

As per claims 2,9, and 10, Johnson in view of Boulton fail to disclose allowing the recipient to suppress (delay) the requiring step within the time period of sensitivity. Nonetheless, it would have been obvious to a person having ordinary skill in the art to allow the recipient to suppress (delay) the requiring step until a later time, wherein the later time is within the time period of sensitivity, if snoozing is allowed. The reason for doing so would be for the benefit of the recipient. If the message does not have to be immediately acknowledged, and he/she were in the process of responding to another important message, it would be beneficial to delay the requirement of the new message so they can finish with their current one. The motivation for allowing this to occur within the time period of sensitivity is because the message is only urgent within the time period.

As per claims 3,19, and 23, although Johnson in view of Boulton does not expressly disclose indicating by the creator an ending time for the time period of the time sensitivity of the message, Boulton does show that responses of feedback can be filtered by time ranges (see column 39, lines 39-41). A person of ordinary skill in the art would have recognized the advantages of requiring an ending time for the time period in order to receive results within a specified time range.

As per claim 4, Johnson in view of Boulton further disclose indicating by the creator, a starting time for the time period of the time-sensitivity of the message (i.e. Boulton sends the electronic mail message to indicate the start time).

As per claim 5, Johnson in view of Boulton further disclose receiving the marked message at the computing device of the recipient (see Boulton column 17, lines 46-50 and 57-61);

determining whether the time period of the time-sensitivity of the received message has been reached (see discussion above regarding use of ending time period); and

requiring the received message to be rendered to the recipient (see Boulton column 17, lines 46-50 and 57-61), and forcing the recipient to respond thereto (see Johnson column 6, lines 42-48), within

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the time period of the time sensitivity if so (i.e. once the message is automatically rendered when time limit is expired, the recipient is forced to respond).

As per claims 7,20,24, Johnson in view of Boulton disclose a system of improving electronic communications, comprising steps of:

receiving a plurality of electronic messages at a computer device of a recipient to whom the electronic messages are addressed (see Boulton column 17, lines 46-50 and 57-61); and

evaluating the received messages for processing by the computing device, further comprising the steps of:

determining whether a selected one of the received electronic messages is time-sensitive (see Boulton column 17, lines 46-50 and 57-61); and

requiring the selected one to be rendered to the recipient (see Boulton column 17, lines 46-50 and 57-61), and forcing the recipient to respond thereto (see Johnson column 6, lines 42-48), within a time period of the time-sensitivity if the determining step has a positive result and the time period of the time-sensitivity has been reached but not exceeded (see discussion of end time period above).

As per claim 11, Johnson in view of Boulton further disclose sending a notification of the response to a computing device of a creator of the rendered selected one (see Johnson column 6, lines 42-48).

As per claim 12, although Johnson in view of Boulton disclose determining whether processing of the rendered selected one is complete (see Johnson et al. columns 7 and 8, lines 63-68 and 1-4, where it is determined if an action taken by the recipient satisfies the response),

it fails to disclose remembering the rendered selected one for subsequent evaluation at a later time within the time period of sensitivity. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Johnson in view of Boulton.

It would have been obvious to a person having ordinary skill in the art to be able to save the incomplete response to the message. Motivation for doing so is in case the recipient needs to leave and

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cannot finish the response immediately; it can be saved and finished at a later time within the period of time sensitivity while the message is still relevant.

As per claim 14, Johnson in view of Boulton further disclose that the electronic messages are e-mail messages (see Johnson Fig. 3 [302]).

As per claim 15, although Johnson in view of Boulton fail to disclose that the electronic messages are calendar events, a person having ordinary skill in the art would have readily recognized that urgent messages that require a response can be associated with calendar events).

As per claim 16, Johnson in view of Boulton further disclose that the electronic messages are to-do items (see Johnson column 7, line 63 – column 8, line 4).

As per claim 17, Johnson in view of Boulton further disclose determining, when the selected one is time-sensitive and the time period of the time-sensitivity is approaching or has been reached but not exceeded, whether a hierarchy of event notification techniques has been defined for various intervals of the time-sensitivity, and if so, selecting a recipient notification technique which corresponds to an amount of time in the time period in addition to or instead of the step of requiring the selected one to be rendered to the recipient (see Boulton column 17, lines 46-61).

As per claim 26, Johnson in view of Boulton further disclose automatically starting execution of an application for rendering the selected one, at the computing device of the recipient, if the execution of the application is not currently started (see Boulton column 17, lines 57-61, where an application is used to stop current activity it in order to render message);

automatically bringing a window rendered by the application to a foreground of a display of the computing device and making the window active (i.e., it would have been obvious to display the email message and not allow the user to exit out until an appropriate action is taken Johnson 4, lines 28-32);

automatically rendering the selected one in the active window (see Boulton column 17, lines 57-61); and

requiring the recipient to take action with the selected one before performing any other tasks with the application (see Johnson 4, lines 28-32).

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Response to Arguments

3. Applicant's arguments with respect to claims 1-5,7,9-12,14-20,22-24 and 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

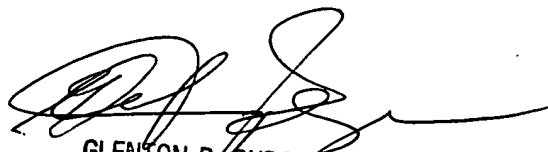
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Philip J Chea
Examiner
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9/21/06


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